

Application No. 10/780,380
Amendment dated April 19, 2006
Reply to Office Action of January 19, 2006

Docket No.: CL 2207 USNA1

REMARKS

This Amendment is responsive to the Office Action mailed January 19, 2006. Applicant respectfully requests reconsideration of the application as amended. Claims 1-7 are currently pending in this application and are subject to examination. Claim 7 has been amended. Support for this amendment can be found in the present application at page 5, lines 21-35.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 7 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner alleges that it is unclear whether claim 7 is an independent or dependent claim because it improperly incorporates by reference the article of claim 1. The preamble of claim 7 has been amended to remove the reference to claim 1 and to more fully describe the article produced by the process of claim 7. Applicant believes that this amendment obviates the indefiniteness rejection of claim 7.

Rejection Under 35 U.S.C. § 103(a)

Claims 1-3 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 02/08327 (hereinafter, Anderle) in view of allegedly admitted prior art. Claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderle in view of the allegedly admitted prior art as applied to claims 1-3 and 6 and in further view of U.S. Patent No. 5,198,523 to Baumann et al (hereinafter, Baumann). Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderle in view of the allegedly admitted prior art as applied to claims 1-3 and 6 and in further view of U.S. Patent No. 5,998,540 to Lipkin et al (hereinafter, Lipkin). Applicant respectfully disagrees that the inventions of these claims would have been obvious to one of ordinary skill in the art, and requests reconsideration of these rejections for the following reasons.

The Examiner's conclusion that all seven claims of the present application would have been obvious is based, in part, on an alleged admission of prior art by the Applicant. The Examiner asserts that Anderle discloses an article made from a polyurethane aqueous dispersion, wherein the polyurethane comprises a THF copolymer and an aromatic diisocyanate, but fails to

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disclose a polyurethane which comprises a THF copolymer soft segment comprising 25-60 percent by weight of ethylene glycol as a comonomer. The Examiner then alleges that the Applicant has admitted on page 5, lines 21-35 of the present application that methods for producing such polyurethanes are known in the art. The Applicant has not made such an admission. The paragraph of the present application cited by the Examiner merely discloses that methods of preparing *copolymers* of THF with 25-60 percent by weight of ethylene glycol as a comonomer are known in the art. (See page 5, line 26: "Methods of preparing such *copolymers* are disclosed in..."). Nowhere in the present application is there any admission that the preparation of polyurethanes from such copolymers is known in the art. To the contrary, Applicant has claimed a such as process as Applicant's invention.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1975). Independent claims 1 and 7 require that the polyurethane comprise a THF copolymer soft segment comprising 25 to 60 percent by weight of ethylene glycol as a comonomer. As already pointed out, the Applicant has made no admission in the present application that methods for preparing such polyurethanes are known in the art, and the Examiner concedes that Anderle fails to disclose such polyurethanes. Furthermore, neither Baumann nor Lipkin teach or suggest this missing limitation. Since Anderle, Baumann and Lipkin, either alone or in combination with each other, fail to teach or suggest all of the limitations of claims 1 and 7, the Examiner has failed to establish that the inventions of these claims are *prima facie* obvious. Accordingly, Applicant respectfully submits that the inventions of claims 1 and 7 are nonobvious, and requests that the obviousness rejection as to these claims be withdrawn. Furthermore, since claims 2-6 are dependent on independent claim 1, which is deemed nonobvious, Applicant respectfully requests that obviousness rejection as to these claims also be withdrawn.

Provisional Nonstatutory Obviousness-Type Double Patenting Rejection

Claim 1 was provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending U.S. Application No. 10/700,859 (hereinafter, the '859 application) and claims 1-8 of copending U.S. Application No. 10/701,317 (hereinafter, the '317 application) in view of the allegedly admitted prior art

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discussed above. Claims 2, 3 and 6 were provisionally rejected on the same grounds as claim 1 in further view of Anderle. Claims 4 and 5 were provisionally rejected on the same grounds as claim 1 in further view of Baumann. Claim 7 was provisionally rejected on the same grounds as claim 1 in further view of Lipkin. Applicants respectfully disagree and request reconsideration of the rejection for the following reasons.

The analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of an obviousness determination under 35 U.S.C. § 103(a). *In re Braat*, 937 F.2d 589, (Fed. Cir. 1991). As when making an obviousness rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing that the claims at issue are *prima facie* obvious when making an obviousness-type double patenting rejection. *In re Longi*, 759 F.2d 887, 896 (Fed. Cir. 1985). The Examiner must present clear evidence that can properly qualify as prior art to establish why the differences between the claims would have been obvious. *In re Kaplan*, 789 F.2d 1574, 1580 (Fed. Cir. 1986).

As was the case above regarding the obviousness rejections of claims 1-7 under 35 U.S.C. § 103(a), the Examiner's rejection of all seven claims of the present application on the ground of nonstatutory obviousness-type double patenting is based, in part, on an alleged admission by the Applicant that methods for producing polyurethanes comprising a THF copolymer soft segment comprising 25-60 percent by weight of ethylene glycol as a comonomer are known in the art. However, as already pointed out above, the Applicant has made no such admission, and the additional references cited by the Examiner (Anderle, Baumann and Lipkin) neither teach nor suggest such a method. Furthermore, the Examiner concedes that neither claims 1-19 of the '859 application nor claims 1-8 of the '317 application recite a polyurethane which comprises a copolymer soft segment comprising 25-60 percent by weight of ethylene glycol as a comonomer. Since the claims of these copending applications, in combination with the references cited by the Examiner, fail to teach or suggest all of the limitations of claims 1-7, the Examiner has failed to establish that the inventions of these claims are *prima facie* obvious. Accordingly, Applicant respectfully requests that the nonstatutory obviousness-type double patenting rejections of claims 1-7 be withdrawn.

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In view of the above amendments and arguments, Applicant believes the pending application is in condition for allowance.

Enclosed is an Authorization to Act in a Representative Capacity.

Applicant believes no fee is due with this response. However, should any fees be required in connection with this Amendment, authorization is hereby made to charge any fees due or outstanding, including any extension fees, or credit any overpayment, to Deposit Account No. 03-2775 (Connolly Bove Lodge & Hutz LLP).

Dated: April 19, 2006

Respectfully submitted,

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Enclosure

Authorization to Act in a Representative Capacity